

REMARKS

1. Applicant acknowledges that claims 1-28 are pending, but believes no further remarks are necessary.
2. The Office rejects claims 1-14 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because they “describe a process without an obvious tie to another statutory class”, *i.e.*, “a claimed process must” be “tied to a particular machine or apparatus” or “transforms a particular article to a different state or thing.” Amended, independent claims 1 and 10, which collectively encompass dependent claims 2-9 and 11-14, are now tied to a machine, *i.e.* “a processing device”, as found in the original specification. Accordingly, Applicant respectfully requests withdrawal of the § 101 rejections directed at claims 1-14.

In addition, the Office rejects claims 15-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, wherein the Office claims “software application is a nonstatutory subject matter.” Amended, independent claim 15, which has claims 16-20 depending therefrom, recite a statutory article of manufacture as contained on the processing device. Similarly, the Federal Circuit, in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995), upheld a computer program as patentable subject matter under 35 U.S.C. § 101 because the computer performing the process was claimed in terms of an article of manufacture as contained on a floppy disk, *i.e.*, a storage medium. Accordingly, Applicant respectfully requests withdrawal of the § 101 rejections directed at claims 15-20.

3. The Office rejects claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Guinta, *et al.*, U.S. Patent No. 5,737,494 (“Guinta”). Applicant objects with traverse to Guinta anticipating Applicant’s claims 1-3.

For a claim to be anticipated, Guinta must describe each element and limitation of that claim.¹ Furthermore, such description must “enable one of skill in the art to make and use

¹ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

the claimed invention”.² Below, Applicant shows that Applicant’s claims 1-3 are not enablingly anticipated by Guinta as a matter of law.

Amended claim 1 states: A method for improving an audit within a controlled environment, the method comprising:

- determining a quality issue to address, the quality issue being associated with a product, wherein the product is the subject of the audit;

- selecting a group of questions associated with the quality issue;

- posing a question of the group of questions to gather information related to evaluation of the quality issue via an interactive interface on a processing device, wherein the interactive interface is adapted for operation within the controlled environment;

- determining a sub-group of the group of questions, the sub-group being selected based upon an association with the information received in response to the question; and

- storing the information.

Contrary to the Office, Guinta describes neither Applicant’s preamble nor Applicant’s first claim element and its limitations. Specifically, the Office points to Guinta at col. 1, ll. 14-50 and chart 1, but Guinta fails to provide the alleged descriptions. Regarding the preamble, Guinta does not describe “within a controlled environment,” which is also a limitation within the body of the claim. That is, there is no description that Guinta may be performed inside a controlled environment.

Additionally and alternatively, at best, Guinta describes “assess[ing] characteristics of the supplier,” wherein “characteristics” are “numerical values.” *See, e.g.*, Guinta’s claims 2 and 3. Furthermore, Guinta “prompts an assessor” “to numerically input the assessor’s perception of the capability of the organizational process or system to address an issue.” Guinta, col. 2, ll. 43-46. Even the Office admits that Guinta describes a system, not a product like Applicant claims. Accordingly, Guinta does not describe “determining a quality

² *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985)).

issue”, much less the “the quality issue being associated with a product”, and “wherein the product is the subject of the audit.”

For another reason, Guinta does not describe Applicant’s second claim element and its limitations. The Office points to Guinta’s table 1, which “depicts issues that may be presented.” However, Applicant submits this does not describe any “selecting...” of anything. Instead, Guinta’s “computer driven questions” “prompts assessors” for numerical input or evidence. *See, e.g.*, Guinta’s claims 1, 7 and 8. Accordingly, Guinta does not describe Applicant’s second claim element and its limitations.

For yet another reason, Guinta does not describe Applicant’s third claim element and its limitations. Although the Office points to Guinta’s Figs. 5A-5E, which “depict a series of ‘sliding bar’ displays” according to Guinta at col. 5, l. 46, there is simply nothing here or elsewhere within Guinta of Applicant’s “the interactive interface is adapted for operation within the controlled environment.” Thus, Guinta does not describe Applicant’s third claim element and its limitations.

Finally, the Office admits on page 9 of the Office Action that Guinta “does not explicitly disclose that the sub-group questions are relevant to a quality issue.” Applicant agrees and this means that Guinta does not describe Applicant’s second element’s limitation of “group of questions associated with the quality issue”, which is necessarily tied to Applicant’s fourth element’s limitation regarding “sub-group of the group of questions” In sum, Guinta also fails to describe Applicant’s fourth element and its limitations.

Based on any of the foregoing reasons, Guinta’s failure to describe each and every element and limitation of Applicant’s claim 1, means Guinta anticipates neither Applicant’s claim 1 nor its dependent claims 2 and 3.³ Applicant agrees with the Office’s non-contention that Guinta, even in view of any of the cited art, does not render obvious Applicant’s claim 1, and, based thereon, then none of its dependent claims 4-9 are not rendered obvious by

³ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998); *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

Guinta, even in view of Prather.⁴ Therefore, Applicant respectfully requests withdrawal of both the anticipation rejections of claims 1-3 and the obviousness rejections of claim 4-9 as a matter of law.

4. The Office rejects claims 15-20 under 35 U.S.C. § 103(a) as being rendered obvious by Guinta in view of Prather, *et al.*, U.S. Pub. Pat. App. No. 2005/0033617 (“Prather”). Applicant objects with traverse to Guinta in view of Prather rendering obvious Applicant’s claims 15-20.

The Supreme Court recently addressed the issue of obviousness in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). “The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) factors still control an obviousness inquiry. Those factors are: (1) ‘the scope and content of the prior art’; (2) the ‘differences between the prior art and the claims’; (3) ‘the level of ordinary skill in the pertinent art’; and (4) objective evidence of nonobviousness.”⁵ “While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation test in an obviousness inquiry, the Court acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does’ in an obviousness determination.”⁶

The *prima facie* case of obviousness requires: 1) some suggestion or motivation in references or in knowledge of those skilled in the art to modify a reference, 2) that the references possess a reasonable expectation of success in the modification or combination, and 3) that the references must teach or suggest all of Applicants’ claim elements and limitations.⁷ Furthermore, the prior art “must also enable one of skill in the art to make and

⁴ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

⁵ *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, *10 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007) (quoting the *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966))).

⁶ *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, *12-13 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. at 1731 (2007)).

⁷ MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

use the claimed invention.”⁸ Below, Applicant shows that Guinta in view of Prather fails to render obvious Applicant’s claims 15-20.

Amended claim 15 states: An apparatus to improve an audit, the apparatus comprising:

a processing device;

an interactive interface, associated with the processing device for use within a controlled environment, to invoke a response to a question from a group of questions associated with the audit and to narrow the group to a sub-group based upon the response to the question, wherein the sub-group is relevant to a quality issue of a product in light of the response;

a question database coupled with the interactive interface, the question database having the group of questions, wherein the group of questions are invoked in an order based upon the response; and

an audit database coupled with the interactive interface, to store data, wherein the data represents the response and responses to other questions from the group.

First, neither Guinta nor Prather teach Applicant’s “processing device for use within a controlled environment.”

Second, Guinta does not allegedly teach “to narrow the group to a sub-group based upon the response to the question” based on Guinta’s FIGS. 1-3. That is, Guinta does not teach narrowing questions. Guinta explicitly describes FIG. 1 as “an apparatus wherein an assessor is prompted to input a numerical input reflective of how well a system addresses an issue,” FIG. 2 as “an apparatus wherein an assessor is prompted to input a numerical input reflective of how extensively a system is deployed,” and FIG. 3 as “an apparatus wherein an assessor is prompted to input a numerical input reflective of results achieved by the system. Furthermore, if demonstrable, then Guinta teaches subsequent evaluation is possible, but this is not a teaching of narrowing. In fact, and unlike Applicant, Guinta expressly teaches “inhibit[ing] display of subsequent questions if evidence is not presented...” Guinta, col. 15, ll. 60-63. In short, there is nothing narrowing about Guinta’s alleged teachings.

⁸ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985) (enabling disclosure required).

Third, for the same reasons alleged in the preceding paragraph, Guinta does not allegedly teach “group of questions are invoked in an order based upon the response.” That is, what FIGS. 1-3 do not teach any invocation of order based upon a response.

Fourth, Applicant agrees with the Office in that Guinta fails to disclose “the sub-group question are relevant to a quality issue.” However, Applicant disagrees that Guinta “further discloses sub-group of relevant questions in table 1 such as topics under different quality concerns” serves one of ordinary skill as a basis to modify “sub-group questions based on relevancy of questions because this would optimize drill down audit questionnaire to inquire relevant features of a product.” Guinta and table 1 expressly teach “issues” that may be presented to an assessor for an “organizational process or system.” Guinta, however, does not teach a quality issue of a product.

Accordingly, for any of these four reasons, Guinta in view of Prather fails to teach all of Applicant’s elements and limitations, and a case for *prima facie* obviousness based thereon is wholly absent.⁹ Therefore, Applicant respectfully requests withdrawal of the obviousness rejection of claim 15, and its dependent claims 16-20, based on Guinta in view of Prather.

5. The Office rejects claims 10-14 under 35 U.S.C. § 103(a) as being rendered obvious by Guinta Applicant objects with traverse to Guinta rendering obvious Applicant’s claims 10-14.

Amended claim 10 states: A method for performing an audit, the method comprising:

interacting via an interactive interface on a processing device within a controlled environment to invoke a response to a question from a group of questions associated with the audit;

⁹ *Takeda Chemical Industries, Ltd., et al. v. Alphapharm Pty., Ltd et al.*, 2007 U.S. App. LEXIS 15349, *10 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007) (quoting the *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966))); *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988)(if independent claim is allowable, then so are the dependent claims).

narrowing the group of questions to a sub-group of the group based upon the response to the question, wherein the sub-group of questions are relevant to a quality issue of a product in light of the response; and

storing the response for analysis.

Applicant respectfully submits that Guinta does not teach or suggest Applicant's first and second elements and their limitations. Specifically, Guinta does not teach the first, second, and fourth reasons asserted above under the Remarks at sub-section 4. Accordingly, for any of these three reasons, Guinta fails to teach all of Applicant's elements and limitations, and a case for *prima facie* obviousness based thereon is wholly absent.¹⁰ Therefore, Applicant respectfully requests withdrawal of the obviousness rejection of claim 10, and its dependent claims 11-14, based on Guinta.

6. The Office rejects claims 21 and 22 under 35 U.S.C. § 103(a) as being rendered obvious by Guinta in view of Danneels, *et al.*, U.S. Pat. No. 6,272,472 ("Danneels"). Furthermore, the Office rejects claims 23-25 under 35 U.S.C. § 103(a) as being rendered obvious by Guinta in view of Danneels and further in view of Prather. Applicant objects with traverse to Guinta in view of Danneels, and for some, further in view of Prather, rendering obvious Applicant's claims 21-25.

Amended claim 21 states: A machine-accessible storage medium containing instructions, which when executed by a machine, cause said machine to perform operations, comprising:

determining a quality issue to address, the quality issue being associated with a product, wherein the product is the subject of an audit;

selecting a group of questions associated with the quality issue;

posing a question of the group of questions to gather information related to evaluation of the quality issue via an interactive interface adapted for operation within a controlled environment;

determining a sub-group of the group of questions, the sub-group being selected based upon an association with the information received in response to the question; and

storing the information.

¹⁰ *Id.*

Claim 21 parallels claim 1, where claim 21 is a Beauregard claim and claim 1 is a method claim. Applicant respectfully submits that since the Office correctly finds Applicant's claim 1 not obvious in light of the cited art of record, then, by straightforward parallel, Applicant's claim 21 is also not obvious in view of the cited art.

However, Applicant submits previous arguments also apply here to show Applicant's claim 21 is not rendered obvious by Guinta in view of Danneels. Specifically, Guinta does not teach Applicant's preamble or Applicant's first, second, third, and fourth claim elements and limitations asserted above under the Remarks a sub-section 3. Accordingly, for any of these five reasons as well as the Office's tacit admission in the same art not rendering Applicant's claim 1 obvious, Guinta clearly fails to teach all of Applicant's elements and limitations, and a case for *prima facie* obviousness based thereon is wholly absent.¹¹ Therefore, Applicant respectfully requests withdrawal of the obviousness rejection of claim 21, and its dependent claims 22-25, based on Guinta, even in view of Danneels and even in further view of Prather.

7. The Office rejects claims 26-28 under 35 U.S.C. § 103(a) as being rendered obvious by Guinta in view of Prather. Applicant objects with traverse to Guinta in view of Prather, rendering obvious Applicant's claims 26-28.

Amended claim 26 states: A machine-accessible storage medium containing instructions, which when executed by a machine, cause said machine to perform operations, comprising:

interacting via an interactive interface to invoke a response to a question from a group of questions associated with an audit;

narrowing the group of questions to a sub-group of the group based upon the response to the question, wherein the sub-group of questions are relevant to a quality issue in light of the response; and

storing the response for analysis.

Claim 26 parallels claim 10, where claim 26 is a Beauregard claim and claim 10 is a method claim. Applicant respectfully submits that Guinta does not teach or suggest Applicant's first

¹¹ *Id.*

and second elements and their limitations. Specifically, Guinta does not teach the first, second, and fourth reasons asserted above under the Remarks at sub-section 4. Accordingly, for any of these three reasons, Guinta fails to teach all of Applicant's elements and limitations, and a case for *prima facie* obviousness based thereon is wholly absent.¹² Therefore, Applicant respectfully requests withdrawal of the obviousness rejection of claim 26, and its dependent claims 27 and 28, based on Guinta even in view of Prather.

¹² *Id.*

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance. Applicant invites the Office to freely reach Applicant's attorney at the contact information found in the signature block below.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

Date: June 24, 2009

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